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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,381	04/05/2000	Michael C. Chen	KTI-001	7208

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EXAMINER

VANDERPUYE, KENNETH N

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 02/13/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,381

Applicant(s)

CHEN ET AL.

Examiner

Kenneth N Vanderpuye

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-16,18-24 and 28-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28,29 and 42-54 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-16,18-24,30-41 and 55-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30-41, 16, 18-24, 55-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claim 30, applicant claims first and second networks and a the circuit switched network. Based on the figures it is clear that one of the networks is a data network (first network). It is not clear what the second network represents.

With regards to claims 16, 55, 58, 61 it is not clear how the sequence of steps achieve the method claimed in the preamble. For example, the first step claims receiving a code from the first station. In the third step the identification of the network address is base ...upon the code. However in the second step the first station connects to a data network and is assigned a network address. It is not clear if the second step occurs before the first step and whether the code is sent over a network other than the data

network. Also with regards to claim 16, in the last two lines of the claim, it is not clear if these step further limit the first step or the third step. (for the sake of clarity applicant advised to list the steps to represent the proper sequence of events)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4, 9-16, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaziri et al (6,377,570).

With regards to claim 1 Vaziri teaches a method comprising: receiving a data network address (each party gets the other parties telephone number, however the IP addresses are exchanged after disconnection Fig. 5@516) for a first station by a second station via a first communication channel routing over a first network(Fig. 5, PSTN), the data network address uniquely identifying the first station; disconnecting from the first communication channel, the first station and the second

station(Fig. 5@508, 510); and causing a second communication channel for voice communication over the second network between the first station and the second station(Fig. 5@518, IT channel), using the data network address received at the second station.(Fig. 5@516). Storing the data network address into a memory associated with the second station(implicitly stored since the called party used this address each time a packet containing voice data is sent across the data network. The decision to remove the address from memory is one of choice since the called party may or may not need the address for future reference. Also as stated earlier the network addresses are exchanged after the disconnection of the call over the PSTN however they are needed to setup the second channel over the internet. The decision to exchange IP addresses before or after disconnecting is obvious as a matter of design choice.

Claim 2 is rejected because Vaziri teaches a gateway (Fig. 9, ISP) for connecting between the PSTN and Internet).

With regards to claim 4, it is well known in the art that the area code of the telephone number of the second station can be used to identify the destination IP gateway, and then determining the route. It would have been obvious to one of ordinary skill in the art to combine this well known art with

Vaziri or the purpose of directing the call across the internet. The motivation being to efficiently distinguish between different gateways.

With regards to claims 9-11, the use of an activation means for sending the IP address is obvious as a matter of design choice. The examples stated in these claims are one of several ways of sending an address to a recipient. As stated earlier the network addresses are exchanged after the disconnection of the call over the PSTN however they are needed to setup the second channel over the internet. The decision to exchange IP addresses before or after disconnecting is obvious as a matter of design choice.

Claim 12 is rejected in light of the reasons for rejecting claim 1. Each step in Fig. 5 is automatic.

Claims 13-15 are rejected because the stations are telephonic devices, the second network is an internet.

Claim 16 is rejected for the same reasons as claim 1.

With regards to claims 22-24, the use of an activation means for sending the IP address is obvious as a matter of design choice. The examples stated in these claims are one of several ways of sending an address to a recipient. As stated earlier the network addresses are

exchanged after the disconnection of the call over the PSTN however they are needed to setup the second channel over the internet. The decision to exchange IP addresses before or after disconnecting is obvious as a matter of design choice.

Claims 5, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaziri as applied to claim 1 above, and further in view of Maroulis(6,584,094).

With regards to claims 5-6, Vaziri fails to teach the step of determining whether the first and second station support a communication over the second network prior to disconnecting. The is taught by Maroulis(see abstract). It would have been obvious to one of ordinary skill in the art to combine Maroulis with Vaziri for the purpose of ensuring that internet communication is supported. The motivation being to avoid disconnecting the call. Claim 6 is rejected because in order to establish internet communication the first PBX has to receive an IP address (appropriate response)from the second PBX.

Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Vaziri as applied to claim 1 above, and further in view of Ho(6,452,922)

With regards to claim 7 Vaziri fails to teach the step of determining if the first and second stations have established the second communications channel...and if not then automatically establishing a third channel using the circuit switched network. This is taught by HO(see abstract). Here is the IP connection cannot be setup a PSTN connection is automatically made. It would have been obvious for one of ordinary skill in the art to combine Ho with Vaziri for the purpose of ensuring that a connection is made if the second network cannot support the connection. The motivation being to save time.

Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Vaziri as applied to claim 1 above, and further in view of Ho(6,452,922) and Schmuelling et al(6,603,758)

Claim 8 is rejected because Schmuelling teaches selecting from a list of ISPs(Fig. 2). It would have been obvious to combine Schmuelling with Ho and Vaziri for the purpose of selecting an ISP that can connect the call. The motivation being to have the option of selecting an ISP in the caller local area.

Allowable Subject Matter

Claims 28-29, 42-49, ~~50~~54 allowed.

Claims 16, 18-24, 55-62 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth N Vanderpuye whose telephone number is 703-308-7828. The examiner can normally be reached on M-F(7:30-5:00) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms can be reached on 703-305-4703. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

KNV
January 9, 2004

Application/Control Number: 09/543,381
Art Unit: 2661

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KENNETH VANDERPUYE
PRIMARY EXAMINER

Ken Vanderpuye
February 9, 2004